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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,954	02/13/2002	Charles Andrianjara	A0000476-01-CFP	9823
28880	7590	03/25/2004	EXAMINER	
WARNER-LAMBERT COMPANY			TRUONG, TAMTHOM NGO	
2800 PLYMOUTH RD			ART UNIT	
ANN ARBOR, MI 48105			PAPER NUMBER	

1624

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/075,954	<b>Applicant(s)</b> ANDRIANJARA ET AL.	
	<b>Examiner</b> Tamthom N. Truong	<b>Art Unit</b> 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-39 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group 1: Claims 1-16 (compounds), 19 (process of making), 29 (composition), 32-34 and 37-39 (methods of use or treatment) – part of each, drawn to the subject matter of formula (I) wherein  $X_1$ ,  $X_2$ , and  $X_3$  are **all**  $CR_6$ , classified in classes 514 and 544, various subclasses depending on substituents.

Group 2: Claims 1-16 (compounds), 19 (process of making), 29 (composition), 32-34 and 37-39 (methods of use or treatment) – part of each, drawn to the subject matter of formula (I) wherein  **$X_1$  is nitrogen** while  $X_2$  and  $X_3$  independently represent  $CR_6$ , classified in classes 514 and 544, various subclasses depending on substituents.

Group 3: Claims 1-16 (compounds), 19 (process of making), 29 (composition), 32-34 and 37-39 (methods of use or treatment) – part of each, drawn to the subject matter of formula (I) wherein  **$X_2$  is nitrogen** while  $X_1$  and  $X_3$  independently represent  $CR_6$ , classified in classes 514 and 544, various subclasses depending on substituents.

Group 4: Claims 1-16 (compounds), 19 (process of making), 29 (composition), 32-34 and 37-39 (methods of use or treatment) – part of each, drawn to the subject matter of formula (I) wherein  **$X_3$  is nitrogen** while  $X_2$  and  $X_1$  independently

represent CR<sub>6</sub>, classified in classes 514 and 544, various subclasses depending on substituents.

Group 5: Claims 1-16 (compounds), 19 (process of making), 29 (composition), 32-34 and 37-39 (methods of use or treatment) – part of each, drawn to the remaining subject matter of formula (I) – e.g. two or all of X<sub>1</sub>, X<sub>2</sub>, and X<sub>3</sub> are nitrogen atoms, classified in classes 514 and 544, various subclasses depending on substituents. Further restriction will be required if this group is elected.

Group 6: Claim 17, drawn to the intermediate of **formula III**, classified in class 544, various subclasses depending on substituents.

Group 7: Claim 18, drawn to the intermediate of **formula IV**, classified in class 544, various subclasses depending on substituents.

Group 8: Claim 20, drawn to an **alternative process** of making formula (I), classified in class 544, various subclasses depending on substituents. Further restriction will be required if this group is elected.

Group 9: Claim 21, drawn to an **alternative process** of making formula (I), classified in class 544, various subclasses depending on substituents. Further restriction will be required if this group is elected.

Group 10: Claim 22, drawn to an **alternative process** of making formula (I), classified in class 544, various subclasses depending on substituents. Further restriction will be required if this group is elected.

Group 11: Claim 23, drawn to an **alternative process** of making formula (I),  
classified in class 544, various subclasses depending on substituents.

Further restriction will be required if this group is elected.

Group 12: Claim 24, drawn to an **alternative process** of making formula (I),  
classified in class 544, various subclasses depending on substituents.

Further restriction will be required if this group is elected.

Group 13: Claim 25, drawn to an **alternative process** of making formula (I),  
classified in class 544, various subclasses depending on substituents.

Further restriction will be required if this group is elected.

Group 14: Claim 26, drawn to an **alternative process** of making formula (I),  
classified in class 544, various subclasses depending on substituents.

Further restriction will be required if this group is elected.

Group 15: Claim 27, drawn to an **alternative process** of making formula (I),  
classified in class 544, various subclasses depending on substituents.

Further restriction will be required if this group is elected.

Group 16: Claim 28, drawn to an **alternative process** of making formula (I),  
classified in class 544, various subclasses depending on substituents.

Further restriction will be required if this group is elected.

Group 17: Claims 30, 31, 35, and 36, drawn to **various methods of use or treatment**, classified in class 514, various subclasses depending on substituents.

Further restriction will be required if this group is elected.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions Group I and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions the compounds in each group are defined by X<sub>1</sub>, X<sub>2</sub>, and X<sub>3</sub>.

a. Although the compounds in the first five groups fall in classes 514 and 544, they are patentably distinct from each other. Even for the compound of pyrido-pyrimidine, the different position of the ring nitrogen (represented by X<sub>1</sub>, X<sub>2</sub>, or X<sub>3</sub>) would set apart one compound from the other. Therefore, a reference that anticipated compounds of one group would not do so to those of other groups. Thus, a separate search for each group is required, which indicates a burdensome search.

b. The inventions of Groups VI and VII are drawn to intermediates of formulae III and IV. Although they are both substituted dioxo-quinazoline, they are patentably distinct from each other by a substituent of R<sub>1</sub>. Furthermore, said intermediates can be used to make other pharmaceutical compounds as well. Thus, said groups require additional search which results in a burdensome search as well.

c. The inventions of Groups VIII – XVI are drawn to various alternative processes of making formula (I). It is obvious that a search for the compounds of formula (I) would not necessarily yield a reference reading on all alternative processes. Therefore, additional search is needed for each alternative process, which results in a burdensome search.

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Due to the complexity of the grouping, the restriction is presented in writing. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 571-272-0676. The examiner can normally be reached on M-T (~10 am ~ 8:30 pm) starting from February 22<sup>nd</sup>, 2004.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached at 571-272-0674. If you are unable to reach Dr. Shah within a 24 hour period, please contact James O. Wilson, Acting SPE of 1624, at 571-272-0661.


The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



T. Truong

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March 22, 2004

  
MUKUND J. SHAH  
SUPERVISORY PATENT EXAMINER  
GROUP 1000

EXAMINER  
SUPERVISORY PATENT EXAMINER  
GROUP 1000